

S/N 10/003,238

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Carlos A. Gonzalez et al.

Examiner: James M. Mitchell

Serial No.: 10/003,238

Group Art Unit: 2813

Filed: October 26, 2001

Docket: 884.535US1

Title: ELECTRONIC ASSEMBLIES WITH FILLED NO-FLOW UNDERFILL (As Amended)

Assignee: Intel Corporation

Customer Number: 21186

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Restriction Requirement mailed June 28, 2005, Applicants reply as follows:

(1) In Paragraph 4 of the Examiner's Office Action Summary, the Examiner stated that claims 22-52 are pending in the application. However, Applicants point out that the pending claims are claims 22-29, 35-40, and 46-52.

(2) Under the heading "Election/Restrictions", the Examiner stated that this application contains claims directed to the following patentably distinct species of the claimed invention: the species of a particle embedded in a terminal that is made from an inhibiting material, the species of a particle embedded in a terminal where the size and shape make it potentially inhibit contact.

(3) The Examiner's characterization of patentably distinct species of the inventive subject matter is unclear and not understood by Applicants for the following reasons:

- (a) None of the pending claims is directed to a "particle" as asserted by the Examiner. Claim 22 is directed to a component package, and claims 27, 37, and 48 are directed to an electronic assembly.
- (b) None of the pending claims is directed to "a terminal that is made from an inhibiting material", as asserted by the Examiner.
- (c) None of the pending claims is directed to "a terminal where the size and shape make it potentially inhibit contact", as asserted by the Examiner.

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Page 2

Dkt: 884.535US1 (INTEL)

(4) In summary, the Examiner's characterization of the claimed inventive subject matter is confusing and incomprehensible and makes it impossible for Applicants to make an informed election of species.

(5) Notwithstanding the above, Applicants elect, under duress, to pursue the species defined by claim 22, as well as those claims dependent upon claim 22, namely claims 23-26, 35, and 46.

(6) In addition, Applicants assert that claim 27 is directed to inventive subject matter that is patentably similar to that of claim 22. Thus, Applicants also elect, under duress, to pursue claim 27, as well as those claims dependent upon claim 27, namely claims 28-29, 36, and 47.

(7) Applicants, under duress, withdraw remaining claims 37-40 and 48-52 without prejudice.

The Examiner is invited to telephone Applicants' attorney, Walter W. Nielsen (located in Phoenix, Arizona) at (602) 298-8920, or the below-signed attorney (located in Minneapolis, Minnesota) to facilitate prosecution of this application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

CARLOS A. GONZALEZ ET AL.

By their Representatives,

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Date Aug 25, 2005 By Ann M. McCrackin
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 25 day of August, 2005.

John N. Ginter-Wrathall
Name

John N. Ginter-Wrathall
Signature